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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,426	06/10/2005	Kazuhiro Yagishita	CU-4247 RJS	3191
26530 7590 12/30/2008 LADAS & PARRY LLP 224 SOUTH MICHIGAN AVENUE SUITE 1600 CHICAGO, IL 60604				
EXAMINER				
GOLOBY, JAMES C				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
12/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,426

Applicant(s)

YAGISHITA, KAZUHIRO

Examiner

James Goloboy

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-18 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/9/08 has been entered.

Claim Objections

2. Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 15 requires that R1 and R2 each be a hydrocarbon with 14 to 18 carbon atoms. However, claim 1, from which claim 15 depends, require that one of the R groups have less than 10 carbon atoms. Claim 15 therefore fails to further limit claim 1.

Claim Rejections - 35 USC § 103

3. Claims 1, 4-8, 10-13, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrick in view of Chambard.

The rejection of claims 1, 4-8, and 10-13 is adequately set forth in paragraph 3 of the office action mailed 7/9/08 and paragraph 3 of the office action mailed 12/10/07, which are incorporated here by reference. Amended claims 1 and 13 include the limitations of previous claim 2, now cancelled, which was rejected over these references in the previous office actions. The salicylate of Carrick and Chambard is a basic salt. The alkyl groups on the salicylate of Chambard additionally contain a number of carbon atoms encompassing the range recited in newly added claims 15 and 17-18.

4. Claims 1, 3, 5-11, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrick in view of Tamoto.

The rejection of 1, 3, 5-11, and 13 is adequately set forth in paragraph 4 of the office action mailed 7/9/08 and paragraph 4 of the office action mailed 12/10/07, which are incorporated here by reference. Amended claims 1 and 13 include the limitations of previous claim 2, now cancelled, which was rejected over these references in the previous office actions. The salicylate of Carrick and Tamoto will be a basic salt as it is included as part of the overbased detergent of Carrick. The alkyl groups on the salicylate of Chambard additionally contain a number of carbon atoms encompassing the ranges recited in newly added claims 14-18.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carrick in view of Katafuchi.

The discussions of Carrick in view of Katafuchi in previous office actions are incorporated here by reference. Carrick and Katafuchi disclose a lubricating oil composition containing all the components of newly added claim 16, including a salicylate which can be made from didodecylsalicylic acid, where the R groups have 12 carbon atoms, within the range recited in claim 16.

Response to Arguments

6. Applicant's arguments filed 10/9/08 have been fully considered but they are not persuasive. Applicant asserts that Carrick in view of Chambard or Tamoto does not teach the alkylsalicylate of the amended claims. The examiner maintains that the references do teach the claimed alkylsalicylate for the reasons stated in the rejection set forth above.

Applicant further argues that Katafuchi does not enable what it discloses, since dodecylmethylsalicylic acid is formed by the alkylation of cresol rather than phenol. Applicant does not provide support for this assertion, but even if it were to be accepted, it is noted that Katafuchi merely discloses that the acids are "typically" obtained by alkylation of a phenol, and does not rule out other synthetic methods.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797